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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,067	06/01/2001	Christopher M. Tobin	50P4053.01	3986

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EXAMINER	
ZHOU, TING	
ART UNIT	**PAPER NUMBER**
2173	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/873,067	TOBIN ET AL.	
	Examiner	Art Unit	
	Ting Zhou	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed on 1/08/2007 have been received and entered. Claims 17-40 are pending in the application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 23-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 23-28 are not tangible. Although the preamble of independent claim 23 recites an apparatus, the remainder of the claim does not support the preamble. The claimed features and elements of independent claim 23 recite modules, which are defined in the specification to be software (page 12, paragraph 30 of the specification). All of the elements of claim 23 would reasonably be interpreted by one of ordinary skill in the light of the disclosure as software, rendering the system/apparatus as software per se, lacking any hardware to enable any functionality to be realized. Therefore, the claimed features of claim 23 is actually a software, or at best, directed to an arrangement of software, and software claimed by itself, without being executed or implemented on a computer medium, is intangible. Claims 24-28 are rejected for the same reasons.

3. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of the applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 17-18, 21-24, 27-30, 33-36 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakobson U.S. Patent 6,697,838 and Revashetti et al. U.S. 6,230,199 (hereinafter "Revashetti").

Referring to claims 17, 23, 29 and 35, Jakobson teaches a method, apparatus, means and computer readable storage comprising identifying a particular resource displayed in a first web page using a device that displays the first web page (the client device which displays the web pages displays, i.e. identifies, a plurality of resources, i.e. URLs) (Jakobson: column 9, lines 46-64 and Figure 2K); determining, with the device, whether an entry corresponding to the particular resource displayed on the first web page is contained in a database on the device that correlates supplemental information to each of a plurality of resources (the processor of the client device determines whether supplemental information such as a note file related to the resource, i.e. the URL, is contained in a database stored on the storage device of the client device)

(Jakobson: column 3, line 6-column 4, line 29 and column 9, lines 46-64), wherein the database is separate from the first web page and the first web page is ordinarily devoid of the supplemental information (the associated note data is displayed when the user clicks on the URL; in other words, if the user does not click on the URL, the web page is devoid of, i.e. does not display the associated note) (Jakobson: column 9, lines 46-64); and displaying supplemental information for the particular resource along with and separate from the first web page where it is determined that the database contains an entry for the particular resource (the supplemental note data is displayed along with, i.e. on the web page, and separate from, i.e. in a separate area on the web page, as shown in Figures 2F and 2K) (Jakobson: column 8, lines 35-51 and column 9, lines 46-64). However, Jakobson fails to explicitly teach that the resource is a product and that the database comprises supplemental information particular to a user. Revashetti teaches a method of providing customized information to a user similar to that of Jakobson. In addition, Revashetti further teaches providing information related to products from a database that comprises supplemental information particular to a user (providing product information based upon user's behavior and preferences from a user profile) (Revashetti: column 1, lines 6-23, column 14, lines 8-17 and column 20, line 45-column 21, line 8). It would have been obvious to one of ordinary skill in the art, having the teachings of Jakobson and Revashetti before him at the time the invention was made, to modify the display of supplemental information related to a selected resource of Jakobson to include the display of product information particular to a user, as taught by Revashetti. One would have been motivated to make such a combination in order to promote and accommodate the growing increase in the use of the Internet for the sale of goods

and products; this combination further allows for more effective marketing/advertisement of products to users.

Referring to claims 18, 24, 30 and 36, Jakobson, as modified, teaches the particular product is a link to a second webpage (the resource is a link, i.e. URL to a web page; selection of the link for the product advertisement takes the user to a related web page) (Jakobson: Figure 2K; Revashetti: column 1, lines 6-23, column 14, lines 8-17 and column 20, line 45-column 21, line 8).

Referring to claims 21, 27, 33 and 39, Jakobson, as modified, teach detecting an event relating to the particular product, wherein the event prompts the display of supplemental information for the particular product (detecting an event such as selection of the resource, i.e. URL, which prompts, or causes the display of the associated note data; detection of an event such as user selection of the product advertisement, which prompts the display of the related web page) (Jakobson: column 3, line 6-column 4, line 29 and column 9, lines 46-64; Revashetti: column 1, lines 6-23, column 14, lines 8-17 and column 20, line 45-column 21, line 8).

Referring to claims 22, 28, 34 and 40, Jakobson, as modified, teach wherein the event is a cursor rollover of the particular product and the supplemental information is superimposed on the first web page in the vicinity of the display of the particular product (when the user selects the URL by moving the cursor to the URL and selecting it, the supplemental note data is displayed on the first web page in the vicinity of, or near the URL, as shown in Figures 2F and 2K) (Jakobson: column 3, line 6-column 4, line 29, column 8, lines 35-51 and column 9, lines 46-64; Revashetti: column 1, lines 6-23, column 14, lines 8-17 and column 20, line 45-column 21, line 8).

5. Claims 19-20, 25-26, 31-32 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakobson U.S. Patent 6,697,838 and Revashetti et al. U.S. 6,230,199 (hereinafter "Revashetti"), as applied to the claims above, and Harris et al. U.S. Patent 6,014,635 (hereinafter Harris).

Referring to claims 19-20, 25-26, 31-32 and 37-38, Jakobson and Revashetti teach all of the limitations as applied to the claims above. Specifically, Jakobson and Revashetti teach a second web page (the resource is a link, i.e. URL to a web page) (Jakobson: Figure 2K) and the supplemental information being obtained from the database and not being ordinarily evident from the webpage (the associated note data stored in the database is displayed when the user clicks on the URL; in other words, if the user does not click on the URL, the web page is devoid of, i.e. does not display the associated note) (Jakobson: column 3, line 6-column 4, line 29 and column 9, lines 46-64). Furthermore, Jakobson and Revashetti teach that the products for which information are displayed are purchasable (Revashetti: column 10, lines 17-23) and suggests that an incentive can be used to entice the customer to purchase an item (Revashetti: column 1, lines 37-39). However, Jakobson and Revashetti fail to explicitly teach a consumer incentive available to the user and relating to the purchasable item. Harris teaches a system for interacting with a user (Harris: column 2, line 18-column 3, line 6) similar to that of Jakobson and Revashetti. In addition, Harris further teaches consumer incentives available to the user relating to the items being purchased, wherein the consumer incentive is a discount for purchasing the items using a particular credit card (using the preferred discount credit system) (Harris: column 2, lines 18-25 and column 2, line 53-column 3, line 6). It would have been obvious to one of ordinary skill in the art, having the teachings of Jakobson, Revashetti and Harris before him at

the time the invention was made, to modify the system for displaying a link to a second web page and supplemental information stored in a database relating to a particular product that is purchasable of Jakobson and Revashetti to include the consumer incentives relating to a purchasable item taught by Harris, in order to obtain a system wherein the second web page correlates to purchasable items and the supplemental information includes consumer incentives such as a discount for purchasing the purchasable item. One would have motivated to make such a combination in order to promote and increase the online sale of goods and services by enticing users to buy the vendor's products.

Response to Arguments

6. Applicant's arguments filed 1/8/2007 have been fully considered but they are not persuasive:

7. With respect to the 35 U.S.C. 101 rejections of claims 23-28, the applicant argues that the corresponding hardware structure for claim 23 is described in Figures 2-3 and paragraphs 0020-0022 and 0032, which recites a computer that comprises memory with several modules corresponding to the functionality recited in claim 23, and therefore, the claims are statutory. The examiner respectfully disagrees. Although Figure 3 shows a diagram of modules within the Navigation Assistance Application, the drawings and corresponding descriptions in the disclosure do not state or show that the modules are necessarily hardware components. Furthermore, page 12, paragraph 0030 of the applicant's specification explicitly states that "Preferably, these modules are provided as software...". Therefore, the "modules" claimed in

claims 23-28 are merely software, or an arrangement of software, lacking hardware components to enable the functionality to be realized; software claimed by itself is not statutory, therefore, the examiner respectfully maintains that claims 23-28 are not statutory.

8. With respect to claims 17-18, 21-24, 27-30, 33-36 and 39-40, the applicant argues that the combination of Jakobson and Revashetti is improper because modifying Jakobson's notes to include downloaded product advertisements would change the principle of operation of Jakobson. The examiner respectfully disagrees. The applicant argues that Revashetti does not disclose inventorying products associated with a displayed webpage. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, in response to applicant's argument that there is nothing in Jakobson that suggests modifying a user's notes to include data created by someone else, and thus modifying Jakobson's notes to include downloaded product advertisements would change the principle of operation of Jakobson, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Jakobson teaches that information from a database related to a particular resource on a webpage is displayed (i.e. displaying note files related to a particular URL), as recited in

column 3, line 6 - column 4, line 29 and column 9, lines 46-64. Similar to Jakobson, Revashetti also teaches displaying related information from a database; in addition, Revashetti teaches that product information related to a user profile are displayed, as recited in column 1, lines 6-23, column 14, lines 8-17 and column 20, line 45 - column 21, line 8. Therefore, the combination of Jakobson's teaching of the display of supplemental information related to a resource with Revashetti's teaching of displaying product information related to a user profile would have suggested to those of ordinary skill in the art, a system which displays related product information particular to a user on a webpage. The applicant also argues that neither reference disclose correlating supplemental information particular to a user about a product as claimed. The examiner respectfully disagrees. As stated above, Revashetti teaches providing supplemental product information based upon preferences from a user profile (column 1, lines 6-23, column 14, lines 8-17 and column 20, line 45 - column 21, line 8); therefore, Revashetti teaches supplemental information particular to a user is correlated with a product.

9. With respect to claims 19-20, 25-26, 31-32 and 37-38, the applicant argues that the Harris reference does not teach the feature lacking from Jakobson and Revashetti, as argued with respect to claims 17-18, 21-24, 27-30, 33-36 and 39-40. The examiner respectfully refers to the response to arguments related to claims 17-18, 21-24, 27-30, 33-36 and 39-40 above and maintains that Jakobson and Revashetti teach the subject limitations.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ

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